Section III. (REMARKS)

The pending claims in the application are 1-8, 12-15, 41 and 42.

Request for Rejoinder Reminder

Applicants respectfully request rejoinder of method claims 19-28, 30-32 and 36-40 upon allowance of the pending composition claims 1-8, 12-15 and 41-42.[1]

Provisional Double Patenting Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

In the May 25, 2006 Office Action, the Examiner provisionally rejected claims 16-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14-16 of copending U.S. Patent Application No. 10/724,791. Applicants have cancelled claims 16-18 thereby obviating this rejection.

In addition, the Examiner provisionally rejected claims 1-8, 12-18, 41 and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Patent Application No. 10/790,535.

According to the Examiner:

> "Although the conflicting claims are not identical, they are not patentably distinct from each other because They [sic] are both directed to a sacrificial silicon-containing layer etching composition comprising a SFC [sic], at least a co-solvent, at least one etchant species which obviously includes the well-known material as disclosed in paragraph [0023] of the copending application, and at least one surfactant." (see May 25, 2006 Office Action, page 3, lines 3-8) (emphasis added)

As a matter of law, the test for obviousness-type double patenting is whether the claimed invention of the subject application would have been obvious from the subject matter of the claims in the cited reference, in light of the prior art. *See, In re Longi*, 225 U.S.P.Q. 645 (Fed.

[1] Rejoinder was previously requested in the response to the September 29, 2005 Office Action, filed October 7, 2005.

Cir. 1985). Further, the initial burden of establishing a *prima facie* case of obviousness is always on the Examiner. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Importantly, the Examiner appears to have relied on paragraph [0023] of the copending application (see May 25, 2006 Office Action, page 3, lines 6-7) ("at least one etchant species which obviously includes the well-known material as disclosed in paragraph [0023] of the copending application . . . ."). As introduced hereinabove, it is improper to resort to the specification when attempting to establish a *prima facie* case of obviousness-type double patenting.

A review of the claims in Application No. 10/790,535 shows that none of the claims motivate, teach or suggest applicants' alkyl phosphonium difluoride ($(R)_4PHF_2$) as claimed in claim 1 of the subject application.

Considered *in toto*, the Examiner has failed to establish a *prima facie* case of nonstatutory obviousness-type double patenting in view of U.S. Patent Application No. 10/790,535. Withdrawal of said rejection is hereby requested.

In the alternative, it is noted that if a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. See MPEP §804. In the present case, the earlier filed application is the present application and as such, if the only rejection remaining in the present case is the ODP rejection in view of U.S. Patent Application No. 10/790,535, and U.S. Patent Application No. 10/790,535 remains rejectable on other grounds, the provisional ODP rejection must be withdrawn.

Rejection of Claims

In the May 25, 2006 Office Action:

claims 16-18 and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Xu et al. (U.S. Patent Application Publication No. 2003/0125225).

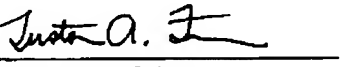
Claims 16-18 and 43 have been cancelled herein thereby obviating the rejection of said claims, however, applicants reserve the right to pursue similar claims in a divisional application claiming priority to Xu et al. (which is assigned to the same assignee as the presently claimed invention).

Conclusion

Claims 1-8, 12-15, 41 and 42 are in form and condition for allowance. Favorable action is hereby requested. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286-8090 to discuss same. Although no known fees are due at this time, the Office is authorized to charge any deficiencies, or credit any overpayments, to Deposit Account No. 13-4365 in the name of Moore & Van Allen PLLC.

Respectfully submitted,

MOORE & VAN ALLEN PLLC

Date: July 25, 2006 By: 

Tristan Anne Fuierer
Registration No. 52,926
Moore & Van Allen PLLC
430 Davis Drive, Suite 500
Morrisville, NC 27560-6832
Telephone: (919) 286-8000
Facsimile: (919) 286-8199